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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,070

08/29/2005

Dietmar Muller

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7590

08/18/2009

THE MAXHAM FIRM

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SAN DIEGO, CA 92121

EXAMINER

WENDELL, ANDREW

ART UNIT

PAPER NUMBER

2618

MAIL DATE

DELIVERY MODE

08/18/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,070	<b>Applicant(s)</b> MULLER ET AL.	
	<b>Examiner</b> ANDREW WENDELL	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 9-16 and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (US Pat Pub# 2004/0203903) in view of Alperovich (US 6,175,741).

As for claim 9, Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network (Abstract and Page 15, Para 0163-0165), wherein the SIM card is configured in such a manner that with the SIM card the terminal device can be connected to only defined destination or source addresses, or both (Sections 0129 and 0165, only users addresses on the friend list are granted permission to communicate with device); and wherein the defined destination and source addresses to which the terminal device can be connected are stored in a memory of the SIM card or in a database of the mobile communication network (Page 15, Para 0163-0165, teaches storing friend list on a removable memory such as a SIM card). Wilson fails to teach excluding call forwarding and default services of a SIM card.

Alperovich teaches wherein call forwarding and default available service number functions of a standard SIM card are excluded from the characteristics of the SIM card

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(Col. 5 lines 40-56, has option of including or exclude call forwarding and other services i.e. call blocking, caller ID, priority, positioning, etc. of the SIM card).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to exclude call forwarding and default services of a SIM card as taught by Alperovich into Wilson's apparatus in order to enhance services for the user (Col. 2 lines 40-48).

As for claims 10 & 28-32, the combination including Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein said SIM card is designed as a Telematic SIM card and wherein the SIM card supports other services that are typically not understood to be Telematic services (Page 1, Para 0003-0004 and Section 0039).

As for claims 11-12, the combination including Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the destination and source addresses are phone numbers, URLs (Uniform Resource Locator) or APN's (Access Point Name) (Page 5, Para 0067; Page 6, Para 0077; Page 14, Para 0155; and Page 15, Para 0163- 0165).

As for claims 13-16, the combination including Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the SIM card only supports defined telecommunication services (Abstract; Sections 0039 and 0043; Page 12, Para 0129; and Page 15, Para 0163-0165).

As for claims 22-27, the combination including Wilson et al. teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the

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SIM card encompasses more than one different subscriber relationship, wherein the use of the SIM card is assigned according to the originator principle to the respective subscriber relationship (Abstract; Page 2, Para 0045; Page 3, Para 0051; Page 4, Para 0056; Page 5, Para 0066; Page 9, Para 0104; Page 12, Para 0129; and Page 15, Para 0163-0165).

Regarding claim 33, process claim 33 is rejected for the same reason as apparatus claim 9 since the recited elements would perform the claimed steps.

3. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson et al. (US Pat Pub# 2004/0203903) in view of Alperovich (US 6,175,741) and further in view of Lipsanen et al. (US Pat Pub# 2002/0059614).

As for claims 17-21, Wilson in view of Alperovich teaches the limitations in claims 9-13. Wilson and Alperovich fails to teach a virtual private network.

Lipsanen teaches a SIM card for operation with a terminal device of a mobile telecommunication network, wherein the mobile phone subscriber relationship associated with the SIM card can only be operated within a defined virtual private network (Page 4, Para 0040-0042 and Page 6, Para 0065, VPN certificates in SIM card).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the storing of VPN information on a SIM card as taught by Lipsanen into excluding call forwarding and default services of a SIM card as taught by Alperovich into Wilson's apparatus in order to receive communication services easier (Section 0009).

***Response to Arguments***

4. Applicant's arguments with respect to claims 9-33 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW WENDELL whose telephone number is (571)272-0557. The examiner can normally be reached on 8:00-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 571-272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nay A. Maung/  
Supervisory Patent Examiner, Art Unit 2618

/Andrew Wendell/  
Examiner, Art Unit 2618

8/10/2009